

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. MOFFETT

Appeal No. 2003-0746
Application No. 09/898,437



ON BRIEF

Before KIMLIN, OWENS AND KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our decision of May 14, 2003, wherein we affirmed the examiner's rejections of all of the appealed claims under 35 U.S.C. § 103.

We have thoroughly reviewed each of appellant's arguments set forth in their request. However, we find that our decision is free of factual and legal error, and we remain of the opinion that the claimed subject matter would have been obvious to one of

ordinary skill in the art within the meaning of § 103 in view of the prior art cited by the examiner.

Appellant submits that we misconstrued the appealed claims in finding that they do not specify that the inorganic colloid and organic polymer perform a precipitation function. To support this argument, appellant notes that claim 1 calls for adding one or more metal ions, an anionic inorganic colloid and inorganic polymer to produce a flocculated mass. Appellant concludes that "[c]ontrary to the Board's reasoning, both claims require the limitation of producing flocculated mass by addition of at least one polymer flocculants [sic, flocculant] to perform a precipitation function" (page 2 of request, 2nd paragraph). However, by appellant's own admission, we did not misconstrue the claims in finding that the claims do not specify that the inorganic colloid and organic polymer perform a precipitation function. Manifestly, Allgulin, like appellant, employs flocculants to produce a flocculated mass.

We also adhere to our opinion that Chung is analogous art. It is our view that "one of ordinary skill in the art would have understood that the treatment process of Allgulin encompasses aqueous streams of the type disclosed by Chung" [page 6 of decision, 1st paragraph). Moreover, as noted at page 5 our

decision, appellant's specification attaches no criticality to the choice of flocculating materials. Chung evidences that the claimed materials were known in the art as flocculating agents.

Appellant also submits that we overlooked the claims in concluding that the claims do not preclude the addition of aluminum-containing chemicals. According to appellant, the recitation of the Markush group effectively confines the metal ions to zinc and manganese ions. However, the "comprising" language of the claims "opens" the claims to the addition of compounds in addition to the recited zinc and manganese ions. As for appellant's statement that "claims are interpreted from the specification and prosecution estoppel applies" (page 3 of request, penultimate paragraph), it is well settled that limitations from the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985).

Appellant also contends that "[c]ontrary to the Board's statement, Chung does not disclose bentonite **and** a polyacrylamide" (page 4 of request, 2nd paragraph). We addressed this argument at the sentence bridging pages 6 and 7 of the decision. We recognized that Chung does not expressly disclose a

combination of bentonite and polyacrylamide, but we explained that it is a matter of prima facie obviousness for one of ordinary skill in the art to combine two or more materials when each is taught by the prior art to be useful for the same purpose, citing In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Appellant's statement that it is "not obvious to combine two or more materials when each is taught to be alternatively used," has no legal support (page 5 of request, 3rd paragraph). Indeed, motivation arises to use a combination of alternative materials when a sufficient amount of the materials is not available. Appellant's arguments concerning unexpected results have been adequately addressed in the decision.

Regarding appellant's argument that the process steps of Allgulin and Chung that are not recited in the appealed claims would materially affect the basis process of removing phosphorus from an aqueous stream, the arguments presented at page 6 of the request lack the requisite factual, evidentiary support.

Appellant repeats the erroneous statement that "appellant's claims are directed to using polymer(s) to produce, *not to remove*, a precipitate" (page 6 of request, penultimate

paragraph). As emphasized at the beginning appellant's request, the appealed claims call for producing a flocculated mass, not to produce a precipitate.

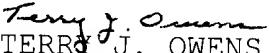
In conclusion, appellant's request is granted to the extent we have reconsidered our decision, but is denied with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

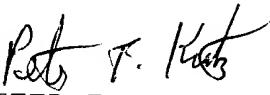
Denied



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TERRY J. OWENS)
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APPEALS AND
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